

**REMARKS**

Claims 1-22 are pending in this application. By this Amendment, claims 1, 16 and 21 are amended. No new matter is added.

**I. Double Patenting Rejection**

Claims 1-22 are provisionally rejected under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of co-pending US Application No. 09/683,329. Applicants concurrently file a Terminal Disclaimer and a Power of Attorney by Assignee in compliance with 37 C.F.R. §§1.321(c), thus overcoming this rejection. Reconsideration and withdrawal of the rejection are respectfully requested.

**II. §102 Rejections**

**A. §102 Rejections Over Yu**

Claims 1, 2, 4-7, 9, 10, 21 and 22 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,688,355 to Yu et al. (Yu). Applicants respectfully traverse the rejection.

Independent claim 1 is directed to a seamless flexible electrostatographic imaging member belt fabrication method, and recites: "applying at least one coating to the seamed belt." Yu does not teach at least this feature of claim 1.

Yu is silent as to applying a coating to the seamed belt. In contrast to the claimed invention, Yu requires coating of the substrate support sheet with an electrically-conductive surface material before producing the seamed belt. See Yu at the Abstract; col. 8, lines 23-38; col. 10, lines 19-23; and Examples 1-5. Thus, as acknowledged at page 4 of the Office Action, Yu teaches away from the claimed invention by requiring coating of the support sheet before forming a seamed belt. Accordingly, Yu does not teach every feature of claim 1.

Claims 2, 4-7, 9 and 10 depend from claim 1, and thus include all of its features.

Accordingly, Yu does not teach every feature of these dependent claims for at least the same reasons as claim 1.

Independent claim 21 is directed to a seamless flexible electrostatographic imaging member belt fabrication method, and recites: "applying at least one coating to the substantially seamless belt, the at least one coating including a photoconductive coating." Yu does not teach at least this feature of claim 21.

As discussed above, Yu is silent as to applying a coating to the seamed belt. In contrast to the claimed invention, Yu requires coating of the substrate support sheet with an electrically conductive surface material before producing the seamed belt. Thus, Yu teaches away from the claimed invention by requiring coating the support sheet before forming a seamed belt. Accordingly, Yu does not teach every feature of claim 1.

Claim 22 depends from claim 21, and thus includes all of its features. Accordingly, Yu does not teach every feature of this dependent claim for at least the same reasons as claim 21.

For at least the reasons discussed above, Yu does not anticipate claims 1, 2, 4-7, 9, 10, 21 and 22. Reconsideration and withdrawal of the rejection of these claims are respectfully requested.

**B. §102 Rejections Over Schlueter**

Claims 16-20 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,997,974 to Schlueter et al. (Schlueter). Applicants respectfully traverse the rejection.

Independent claim 16 is directed to a seamless flexible electrostatographic imaging member belt fabrication method, and recites: "overlapping and bonding the first desired

features with the second desired features to produce a substantially seamless belt." Schlueter does not teach at least this feature of claim 16.

As disclosed in Figs. 5 and 6 of the instant specification, and as explained at page 4 of the previous Amendment, claim 16 is directed towards lap joints (e.g., overlapping joints) as opposed to edge cutting (e.g., puzzle joints). In contrast to claim 16, Schlueter requires puzzle joints whose mating elements have a gap between them to which adhesive material is applied. See Schlueter at the Abstract and col. 3, lines 40-54. In fact, Schlueter teaches away from the claimed invention by prohibiting overlapping joints. See Schlueter at column 1, lines 50-52 and 60-65. Thus, Schlueter does not teach or suggest "overlapping and mating the first and second desired features," as required by claim 16.

Claims 17-20 depend from claim 16, and thus include all of its limitations. Accordingly, Schlueter does not teach every feature of these dependent claims for at least the same reason as claim 16.

For at least the reasons discussed above, Schlueter does not teach every feature of claims 16-20, and thus Schlueter does not anticipate claims 16-20. Reconsideration and withdrawal of the rejection of these claims are respectfully requested.

### **III. §103 Rejections**

#### **A. §103 Rejections Over Schlueter and Yu**

Claims 1-22 are rejected under 35 U.S.C. §103(a) as being unpatentable over Schlueter in view of Yu. Applicants respectfully traverse the rejection.

##### **1. Schlueter Cannot Be Combined With Yu**

As discussed above, Schlueter discloses puzzle joints whose mating elements have a gap therebetween to which adhesive material is applied, and applying a bonding to the seam of the belt. Schlueter requires puzzle joints and application of a bonding to the seam, and

prohibits overlapping joints. As discussed above, and in direct opposition to Schlueter, Yu discloses overlapping joints and coating the substrate support sheet with an electrically-conductive surface material before producing the seamed belt. Yu requires overlapping joints and coating of the substrate before forming the seam, and is silent as to coating of the seamed belt.

Modifying Schlueter based on the disclosure of Yu would require modifying Schlueter to have overlapping joints as opposed to puzzle joints, and to coat the substrate before forming the seam, as opposed to coating the seamed belt. Schlueter's intended purpose is to create an endless flexible seamed belt with a mechanically and electrically invisible puzzle-cut seam, and requires puzzle joints and application of a bonding to the seam to achieve this goal. Thus, modifying Schlueter based on the disclosure of Yu would destroy Schlueter for its intended purpose. MPEP §2143.01 states: "If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)." Thus, in view of MPEP §2143.01, there is no motivation or suggestion for one skilled in the art to modify Schlueter based on Yu.

In addition, although Yu discloses overlapping joints, the disclosure of Yu taken as a whole teaches away from Schlueter. MPEP §2141.02 states: "A prior art reference must be considered in its entirety, i.e., as a whole, including portion that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Gardlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)." (Emphasis in original). In view of MPEP §2141.02, it is improper to focus only Yu's disclosure of overlapping joints, based solely on the teachings of the instant application, without considering Yu teaching of coating of the substrate before forming the seam. Yu's disclosure of overlapping joints and of

coating the substrate before forming the seem are both in direct opposition to Schlueter.

MPEP 2415 states: "It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983)." Accordingly, because Yu must be considered as a whole and because Yu teaches away from Schlueter, it is improper to combine Schlueter and Yu.

**2. Claims 1-22 Are Patentable Over the Cited References**

Claims 1, 2, 4-7, 9, 10, and 16-22, Schlueter and Yu are discussed above. For at least the reasons discussed above, neither Schlueter nor Yu independently teaches or suggests every feature of claims 1, 2, 4-7, 9, 10, and 16-22. Claims 3 and 8 depend from claim 1 and thus include all of its limitations. Accordingly, neither Schlueter nor Yu independently teaches or suggests every feature of these dependent claims for at least the same reasons as claim 1.

Claim 11 is directed to a seamless flexible electrostatographic imaging member belt fabrication method, and recites: "overlapping and bonding the first desired pattern with the second desired pattern to produce a seamed belt" and "coating the seamed belt with a photoconductive material." Neither Schlueter nor Yu independently teaches every feature of claim 11.

As discussed above, Schlueter does not teach or suggest the claimed overlapping, and teaches away from the claimed invention by requiring puzzle joints and prohibiting overlapping. As discussed above, Yu does not teach or suggest the claimed coating of the seamed belt, and teaches away from the claimed invention by remaining silent as to applying a coating to the seamed belt and requiring coating of the substrate support sheet before producing the seamed belt. Thus, for at least the reasons discussed above, neither Schlueter nor Yu independently teaches or suggests every feature of claim 11.

Claims 12-15 depend from claim 11, and thus include all of its limitations.

Accordingly, neither Schlueter nor Yu independently teaches or suggests every feature of these dependent claims, for at least the same reasons as claim 11.

For at least the reasons discussed above, claims 1-22 are patentable over each of Schlueter and Yu. Reconsideration and withdrawal of the rejection of these claims are respectfully requested.

**B. §103 Rejections Over Schlueter, Yu and Asahi**

Claim 3 is rejected under 35 U.S.C. §103(a) as being unpatentable over Schlueter in view of Yu and further in view of U.S. Patent No. 6,120,725 to Asahi et al. (Asahi).

Applicants respectfully traverse the rejection.

Claims 1 and 3, Schlueter and Yu are discussed above. For at least the reasons discussed above, neither Schlueter nor Yu independently teaches or suggests every feature of claim 1. Claim 3 depends from claim 1 and thus includes all of its limitations. Accordingly, neither Schlueter nor Yu independently teaches or suggests every feature of this dependent claim for at least the same reasons as claim 1.

Asahi is cited for its teaching of using multiple masks in a laser ablation process. However, Asahi fails to overcome the deficiencies of Schlueter and Yu. Specifically, Asahi does not teach or suggest "overlapping the first and second desired features," as required by claim 3. In addition, Asahi fails to overcome the deficiencies of Yu. Specifically, Yu does not teach or suggest "applying at least one coating to the seamed belt," as required by claim 3.

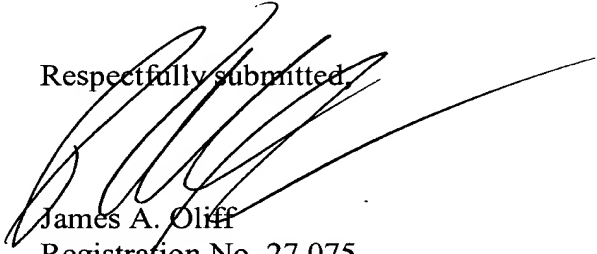
For at least these reasons, claim 3 is patentable over Schlueter, alone or in view of Asahi. In addition, claim 3 is patentable over Yu, alone or in view of Asahi. Reconsideration and withdrawal of the rejection of this claim are respectfully requested.

**IV. Conclusion**

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-22 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

  
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**Attachments:**

Power of Attorney by Assignee w/Appendix  
Terminal Disclaimer

Date: January 7, 2004

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